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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,989	07/15/2003	Giora Biran	IL920000078US1	8807

54856 7590 10/18/2006

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EXAMINER
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NGUYEN, TANH Q

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/619,989

Applicant(s)

BIRAN ET AL.

Examiner

Tanh Q. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07/06/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Attachment to office Action.

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## ATTACHMENT TO OFFICE ACTION

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed July 6, 2006 fails to comply with 37 CFR 1.97(c) because it includes a statement as specified in 37 CFR 1.97(e) specifying that each item in the information disclosure statement is submitted within three months of the date it was cited in any communication from a foreign patent office in a counterpart foreign application, yet it includes JP 11-175491 which was cited as Patent family member of EP 0908830 A in the International Search Report for PCT/IB01/00121, the International Search Report being made part of WO 02/061590 A1 published on August 8, 2002 (see attachment to office action). Furthermore, it is noted that part of Form PTO-1449 is not legible, that the country information is not provided, and that it is not clear what PUPA means. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Objections***

2. Claim 11 is objected to because "step" in line 2 should be replaced with --steps--.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-10, 17-18, 21-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites a "buffer storing indications of interrupts" in line 2, "moving the contents of the buffer to the payload portion of the control data block, and sending the control data block to the host computer system" in lines 7-9. The recitations suggest that indications of interrupts are being transferred to the host computer system, yet claim 1 also recites "said apparatus for transferring interrupts from the peripheral device to a host computer" in lines 3-4. The specification does not disclose transferring interrupts and indications of interrupts to the host computer.

5. Claims 11-16, 19-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Page 40, lines 3-5 discloses "The payload portion comprises a plurality of fields each containing the identity of the LCP channel that indicated the

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completion event". It appears that the cited portion only supports a payload portion having a plurality of fields, each corresponding to one of the ports - rather than to a different one of the ports.

In the example of FIG. 18, there are 28 fields in the payload portion. Each field of payload portion contains the identity of the LCP channel (ports) that indicated the completion event (the interrupt) - hence a payload portion having a plurality of fields, each corresponding to one of the ports. The limitation "a plurality of fields each corresponding to a different one of the port" would require 28 different ports, and such limitation appears not to be supported by the specification.

Furthermore, it appears that there is no support for "moving the contents of the buffer to the corresponding fields of the payload portion" - as page 38, lines 25-26 merely discloses "when preset conditions are met, an Interrupt Control Block (ICB) 1680 is generated by the ISOC 120 from the information stored in the interrupt FIFO 1660".

6. Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 13 recites "at least a predetermined plurality of indications is stored in the buffer". Claim 14 recites "at least one indication is stored in the buffer".

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Claim 15 recites "a count indicative of the number of indications included in the payload portion". The claims suggest that interrupts and indications are two different entities, while the specification only discloses only one entity being stored in the buffer and the count being indicative of only one entity.

7. Claims 10, 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner cannot find support for the limitations of the claims. In particular, it is not clear what constitute the claimed apparatus, the claimed host processing system, the claimed memory of the host processing system, the claimed data processing system, the claimed host computer, and the claimed memory of the host computer system. Applicant is required to specifically point out where to find the support for the limitations of the claims in the specification, by page and line number - and in particular, applicant is required to map out each of the elements claimed with the teachings of the specification.

8. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "the peripheral device having a plurality of ports" in lines 2-

3. Claim 1 also recites "a port" in line 9. It is not clear that the recited "a port" is

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a port of the peripheral device. Claim 1 also recites "via one of the ports" in line 12. It is not clear that the recited "one of ports" is a port of the peripheral device.

Claim 11 recites "the peripheral device having a plurality of ports" in line 2. Claim 11 also recites "a different one of the ports" in line 7. It is not clear that the recited "a different one of the ports" is a port of the peripheral device. Claim 11 also recites "via one of the ports" in line 10. It is not clear that the recited "one of ports" is a port of the peripheral device.

9. Claims 8-10, 17-20, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites "A peripheral device comprising the apparatus claimed in claim 1" in line 1, and claim 9 depends on claim 8. Since claim 1 also recites "a peripheral device" in line 2, it is not clear whether the peripheral device of claim 8 is the same as the peripheral device of claim 1. Claim 8 needs to be amended to indicate either one peripheral device, or two peripheral devices.

Claim 10 recites "the memory of the host computer system" in lines 4-5. There is insufficient antecedent basis for the limitation in the claim.

Claim 17 recites "the functions of all the elements " in lines 4-5. There are insufficient antecedent bases for "the functions" and "the elements" in the claim. Furthermore it is not clear what "the functions of all the elements" means.

Claim 18 recites "the functions of all the elements " in lines 4-5. There are insufficient antecedent bases for "the functions" and "the elements" in the claim.



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Furthermore it is not clear what "the functions of all the elements" means.

Claim 19 recites "the steps and all the limitations of the steps" in lines 4-5. There are insufficient antecedent bases for "the steps" and "the limitations of the steps" in the claim. Furthermore it is not clear what "the steps and all the limitations of the steps" means.

Claim 20 recites "the steps and all the limitations of the steps" in line 3. There are insufficient antecedent bases for "the steps" and "the limitations of the steps" in the claim. Furthermore it is not clear what "the steps and all the limitations of the steps" means.

Claim 22 recites "the memory of the host computer system" in lines 4-5. There is insufficient antecedent basis for the limitation in the claim.

### ***Response to Arguments***

10. Applicant's arguments filed August 1, 2006 have been fully considered but they are not persuasive or moot in view of the new grounds of rejections.

11. With respect to the rejections of claims 11-16, 19-20 under 35 USC 112 first paragraph, applicant argued that the amendment to the specification to include the matter in the claims to meet the enablement requirement of USC 112 enables and supports a method with a payload portion having a plurality of fields, each corresponding to a different one of ports, and moving the contents of the buffer to the corresponding fields of the payload portion - since any matter in the claims as originally filed is deemed to be old and proper matter, and the embodiment recited by the claims need not meet the criteria of the example of

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FIG. 18.

The argument is not persuasive because applicant included essentially the same matter in the claims, but the matter was **still** not described in the specification in such a way as to **enable one skilled in the art** to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While the claims need not meet the criteria of the example of FIG. 18, there is nothing in the specification that shows one skilled in the art **how** to practice the invention with a payload portion with a plurality of fields and with each of the plurality of fields corresponding to a different one of ports, and further moving the contents of the buffer to the corresponding fields of the payload portion.

A specification that is ambiguous about the presence or absence of a claimed limitation cannot be considered to teach the existence of the claimed limitation.

12. With respect to the rejections of claims 8-9 under 35 USC112, second paragraph, applicant argued that the amendment to claims 8-9 overcome the rejections. The argument is not persuasive because it is still not clear whether the peripheral device in claim 8 is the same as the peripheral device of claim 1.

13. With respect to claims 8-9, 17-20, it appears that attempts to keep the claims in dependent form so far have only rendered the claims unclear. The examiner suggests that applicant considers rewriting the claims in independent form to overcome the rejections.

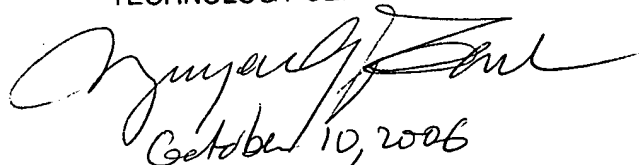
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Q. Nguyen whose telephone number is 571-272-4154. The examiner can normally be reached on M-F 9:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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October 10, 2006

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October 10, 2006